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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,292	07/30/2001	Mitsuru Ohgake	R2184.0117/P117	8277

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EXAMINER

AGUSTIN, PETER VINCENT

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/916,292

Applicant(s)

OHGAKE, MITSURU

Examiner

Peter Vincent Agustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

2. The drawings are objected to because of the following minor informalities:

Figure 3, step S2: "STRATEGE" should be --STRATEGY--.

Figure 3, step S8: "CORRESPONS" should be --CORRESPONDS--.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors, e.g.,

Page 8, line 6: "of" should be --for--.

Page 8, line 17: "device" should be --medium--.

Page 8, line 25: "an" should be deleted.

Page 9, line 5: "managing" should be --manage--.

Page 9, line 7: "storing" should be --store--.

Page 9, line 13: "conducting" should be --conduct--.

Page 14, line 18: "first" should be --second--.

Page 16, line 5: "executed" should be --execute--.

Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

*Claim Objections*

5. Claims 3, 6-11, 14 & 17-20 are objected to because of the following informalities:

Claim 3, line 6: "transfer" should be --transferring--.

Claim 3, line 8: "corresponding" should be --corresponding to--.

Claim 6, line 3: "are stored" should be --is stored--.

Claim 7, line 1: "wherein" should be --wherein in--.

Claim 7, line 2: "step (b)" should be --step (b),--.

Claim 8, line 16: "stored said" should be --stored in said--.

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Claim 8, line 21: "strategy:" should be --strategy;--.

Claim 14, line 4: "transfer" should be --transferring--.

Claim 14, line 6: "corresponding" should be --corresponding to--.

Claim 17, line 3: "of" should be --for--.

Claim 17, line 14: "stored said" should be --stored in said--.

Claim 17, line 19: "strategy:" should be --strategy;--.

Claim 20, line 3: "of" should be --for--.

Claims 9-11, 18 & 19 are dependent upon objected base claims.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5, 8-11 & 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "said step (h)" on line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "said device information and said medium information" on e.g., lines 4-5. There is insufficient antecedent basis for these limitations in the claim.

Claim 13 recites the limitation "the device information and the medium information" on e.g., lines 4-5. There is insufficient antecedent basis for these limitations in the claim.

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Claim 14 recites the limitation "said standard strategy information" on line 3.

There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "said code (h)" on line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "said code (i)" on line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 9-11, 15, 17, 19 & 20 are dependent upon rejected base claims.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7 & 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bakx (US 5,072,435).

In regard to claim 1, Bakx discloses a method for optically recording information in a system (figure 1) comprising a recording and reading device (3) that includes a strategy part (8 & 9) for conducting a strategy when optically recording information and an information processing apparatus (5) that includes a strategy information storing part (12) storing the strategy information for operating said strategy part, said method comprising the steps of: (a) reading said strategy information (column 4, line 34: "adjustment data") for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus (column 4, lines 22-25); and (b) transmitting said strategy information read in said step

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(a) to said recording and reading device (as shown by arrows associated between 5 & 8 and 5 & 9).

In regard to claim 2, Bakx discloses the steps of: (c) storing said strategy information (column 4, lines 34-37) information of said recording and reading device and medium information of an optical recording medium (column 4, lines 26-29) to said strategy information storing part; (d) transmitting the device information and the medium information from said recording and reading device to said information processing apparatus (as shown by the arrows between elements 5 & 8); (e) reading said strategy information corresponding to said device information and medium information from said strategy information storing part in said information processing apparatus (column 4, lines 22-25); and (f) transmitting said strategy information with said medium information to said recording and reading device (as shown by arrows associated between 5 & 8 and 5 & 9).

In regard to claim 3, Bakx discloses the steps of: (g) storing standard strategy information to said strategy storing part (column 5, lines 64-66); (h) reading said standard strategy information and transferring said standard strategy information to said recording and reading apparatus when the strategy information corresponding the device information and the medium information transmitted from said recording and reading device is not stored in said strategy information storing part (column 5, line 62 thru column 6, line 1).

In regard to claim 6, Bakx discloses that a plurality of data sets of the strategy information is stored in said strategy part (column 5, lines 58-61).

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In regard to claim 7, Bakx discloses that in said step (b), transmitting said strategy information (figure 2, step A13) is conducted just before starting recording information (step A18) to said optical recording medium.

In regard to claim 12, Bakx discloses a computer-readable recording medium (figure 1, element 1) recorded with program code for causing a computer to optically record information in a system comprising a recording and reading device (3) that includes a strategy part (8 & 9) for conducting a strategy when optically recording information and an information processing apparatus (5) that includes a strategy information storing part (12) storing the strategy information for operating said strategy part, said program comprising the codes for: (a) reading said strategy information (column 4, line 34: "adjustment data") for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus (column 4, lines 22-25); and (b) transmitting said strategy information read by said code (a) to said recording and reading device (as shown by arrows associated between 5 & 8 and 5 & 9).

In regard to claim 13, Bakx discloses (d) transmitting the device information and the medium information from said recording and reading device to said information processing apparatus (as shown by the arrows between elements 5 & 8); (e) reading said strategy information corresponding to said device information and medium information from said strategy information storing part in said information processing apparatus (column 4, lines 22-25); and (f) transmitting said strategy information with said medium information to said recording and reading device (as shown by arrows associated between 5 & 8 and 5 & 9).



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In regard to claim 14, Bakx discloses reading said standard strategy information and transferring said standard strategy information to said recording and reading apparatus when the strategy information corresponding the device information and the medium information transmitted from said recording and reading device is not stored in said strategy information storing part (column 5, line 62 thru column 6, line 1).

In regard to claim 4 & 15, Bakx discloses that said medium information is read and obtained from the optical recording medium (column 4, lines 26-29).

In regard to claims 5 & 16, Bakx discloses canceling transmitting said device information and said medium information (column 4, lines 29-32: note that "not necessary to carry out a new calibration procedure" corresponds to the claimed transmission of information being canceled) to said information processing apparatus when said medium information additionally provided to said strategy information stored in said strategy part corresponds to said medium information (column 4, lines 22-29) of said optical recording medium, and activates said strategy part to record to the optical recording medium (see also column 4, lines 46-50).

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ashinuma et al. (US 5,289,451) discloses an apparatus having a controller for controlling the parameters of a processor in response to a detected disk type.

Bakx (US 5,226,027) discloses a recording method and device which provides an optimum setting of a record carrier dependent recording parameter.

Nakajo (US 5,502,702) discloses an optical disc recording device having a control information memory storing a plurality of control information.

*Allowable Subject Matter*

11. Claims 8-11 & 17-20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest:

In claim 8, a method for optically recording information comprising the steps of:  
(a) reading strategy information from a strategy information storing part; and (b) transmitting said strategy information to a recording and reading device, wherein a plurality of data sets of the strategy information is stored in said strategy part, further comprising the steps of: **(i) storing registration information in addition to said device information and said medium information to said strategy information storing part; (j) transmitting said registration information additionally provided to said medium information to said recording and reading device and storing said medium information with said registration information to said strategy part, when said strategy information is transmitted from said information processing apparatus to said recording and reading device; (k) determining said strategy information, which is stored in said strategy part, to be deleted based on said registration information stored said strategy part and deleting determined strategy information, when said strategy information transmitted from said information processing**

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**apparatus cannot be stored because of a shortage of a recording capacity of said strategy;** and (l) storing said strategy information transmitted from said information processing apparatus.

In claim 17, a computer-readable recording medium recorded with program code for comprising the codes for: (a) reading strategy information for operating a strategy part and (b) transmitting said strategy information to a recording and reading device, (d) transmitting device information and medium information to an information processing apparatus; (e) reading said strategy information from said strategy information storing part; and (f) transmitting said strategy information with said medium information to said recording and reading device, further comprising the codes of: **(j) transmitting said registration information additionally provided to said medium information to said recording and reading device and storing said medium information with said registration information to said strategy part, when said strategy information is transmitted from said information processing apparatus to said recording and reading device; (k) determining said strategy information, which is stored in said strategy part, to be deleted based on said registration information stored in said strategy part and deleting determined strategy information, when said strategy information transmitted from said information processing apparatus can not be stored because of a shortage of a recording capacity of said strategy;** and (l) storing said strategy information transmitted from said information processing apparatus.

Claims 9-11 & 18-20 are dependent upon base claims having allowable subject matter.

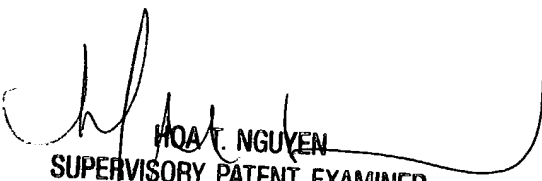
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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is 703-305-8980. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 703-305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin  
Art Unit 2652  
August 4, 2004

  
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8/9/04